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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

190

Application Number	09/910,641
Filing Date	July 20, 2001
First Named Inventor	PERRIANN M. HOLDEN
Art Unit	3765
Examiner Name	ALISSA HOEY
Attorney Docket Number	810101-1

### ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
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<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	CREDIT CARD AUTHORIZATION FORM
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<input type="checkbox"/> Response to Missing Parts/Incomplete Application	CHARGE CREDIT CARD FOR ANY ADDITIONAL FEES OR ANY UNDERPAYMENT OF FEES BRIEF IS IN TRIPLICATE	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

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### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	LAW OFFICE OF JERRY R. POTTS
Signature	
Date	JANUARY 3, 2004

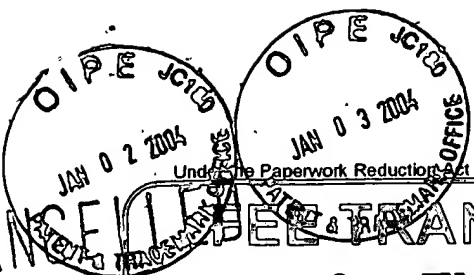
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Signature	
Date	JANUARY 3, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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# FREE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 165.00

## Complete if Known

Application Number 09/910.641  
Filing Date July 20, 2001  
First Named Inventor PerriannM. Holden  
Examiner Name AlissaHoey  
Art Unit 3765  
Attorney Docket No. 810101-1

## METHOD OF PAYMENT (check all that apply)

☒ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None

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## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$ )

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	20** =	X	
Independent Claims	3** =	X	
Multiple Dependent			

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ )

\*\*or number previously paid, if greater. For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity - Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	165.00
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 165.00

## SUBMITTED BY

Name (Print/Type) JERRY R. POTTS

Signature

Registration No. (Attorney/Agent)

27,091

(Complete if applicable)

Telephone 760-822-6201

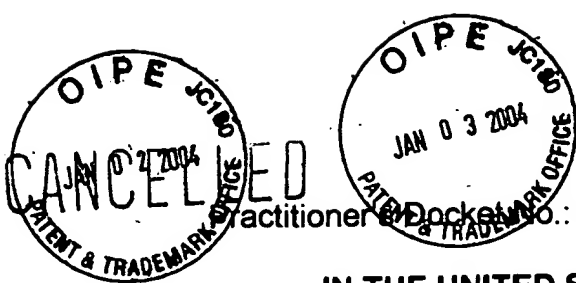
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Practitioner's Docket No.: 810101-1

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

#25  
ff  
1-15-4

In re application of Perriann M. Holden	)	
	)	
Application No. 09/910,641	)	Group No: 3765
	)	
Filed July 20, 2001	)	Examiner: Alissa Hoey
	)	
For: Protective Attachment	)	

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**TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION - 37 C. F. R. §1.192)**

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on December 13, 2003.

**CERTIFICATE OF TRANSMITTAL UNDER 37 C.F.R. § 1.8(A) AND 1.10**

I hereby certified that, on the date shown below, this correspondence is being Deposited with the United States Postal Service, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 as "Express Mail Post Office to Addressee" Mailing Label No ER 310156408 US.

Date: January 3, 2004

PRINTED NAME: JERRY R. POTTS

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## 2. STATUS OF APPLICANT

This application is on behalf of a small entity and a statement was already filed.

## 3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F. R. § 1.17 ( c), the fee for filing the Appeal Brief is \$165.00 for a small entity status.

## 4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

## 5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee: \$165.00

Extension fee: None

**TOTAL FEE DUE: \$165.00**

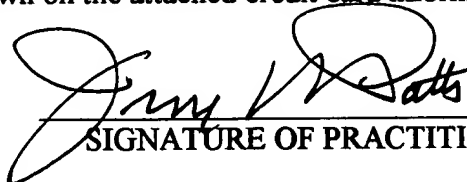
## 6. FEE PAYMENT

Attached is a check in the amount of \$165.00.

## 7. FEE DEFICIENCY

If any additional extension and/or fee is required, or if any additional fee for claims is required, charge the credit card as shown on the attached credit card information authorization form PTO-2038.

Date: January 2, 2004

  
SIGNATURE OF PRACTITIONER

Customer No.: 33651

Registration NO.: 27,091

Law Office of Jerry R. Potts  
3248 Via Ribera  
Escondido, CA 92029

Practitioner's Docket No.: 810101-1

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of Perriann M. Holden	)	
	)	
Application No. 09/910,641	)	Group No: 3765
	)	
Filed July 20, 2001	)	Examiner: Alissa Hoey
	)	
For: Protective Attachment	)	

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**APPELLANT'S BRIEF (37 C. F. R. §1.192)**

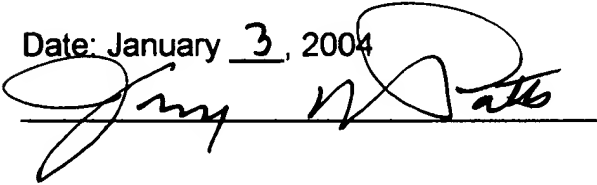
This brief is in furtherance of the Notice of Appeal, filed in this case on December 13, 2003.

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**CERTIFICATE OF TRANSMITTAL UNDER 37 C.F.R. § 1.8 (a)**

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Date: January 3, 2004



PRINTED NAME: JERRY R. POTTS

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c):

- I REAL PARTY IN INTREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF INVENTION
- VI ISSUES
- VII GROUPING OF CLAIMS
- VIII ARGUMENTS
  - ARGUMENTS VIIIA REJECTIONS UNDER 35 USC 102
  - ARGUMENTS VIIIB REJECTIONS UNDER 35 USC 103
- IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

The final page of this brief bears the practitioner's signature.

## **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is the party named in the caption of this brief.

## **II. RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal there are no such appeals or interferences.

## **III. STATUS OF CLAIMS**

The status of the claims in this application is:

### **A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION**

Claims in the application are: Claims 21-23, 27, 29 and 32.

**B. STATUS OF ALL THE CLAIMS**

1. Claims cancelled: 1, 5-6, 10-11, 24-26, 28, 30-31, 33, 35-41, and 44.
2. Claims withdrawn from consideration but not cancelled: 2-4, 7-9, 12-20, 34, 42-43, and 45-46.
3. Claims pending: 21-23, 27, 29 and 32.
4. Claims allowed: NONE.
5. Claims rejected: 21-23, 27, 29 and 32.

**C. CLAIMS ON APPEAL**

1. The claims on appeal are claims 21-23, 27, 29 and 32.

**IV. STATUS OF AMENDMENTS**

Insofar, as understood by the appellant, the amendment filed on November 8, 2003 in response to the final rejection mailed on October 3, 2003 and the Advisory Action mailed on October 31, 2003 will be entered and an explanation of how the new or amended claims would be rejected has been provided by the examiner stating that "Claims 21-23, 29 and 32 stand rejected under 35 USC 102 (b) as anticipated by Yonkers (U.S. 3,985,383) and claims 27 stands rejected under 35 USC 103(a) [over] Yonkers in view of Lee (U.S. 6,613,382)."

**V. SUMMARY OF THE INVENTION**

The preferred embodiment of the present invention is a single piece novelty decorative fashion wear item (FIGS. 1-2 and 18; page 1, lines 23-24) that comprises a thin flexible pad **10** (FIGS 1-2, and 18) that removably attaches in a snug tight fit to a selected body part, such as the feet, hands, elbows and knees (FIGS. 1 and 12 B for example, page 1, lines 23-25) and that conforms to the body part covered (FIGS. 1-2, page 1, lines 21-22 and page 2, lines 23-25). To facilitate decorating a desired contoured surface area of the body, the entire upper surface **12** (FIG. 18) of the pad **10** is completely coated with an adhesive

material **14, 17** (FIG. 18, page 3, lines 29 to page 4, lines 1-17) that allows the pad **10** to be removably secured (page 5, lines 12-14). The lower surface **13** (FIG. 18) has a non-slip texture (page 4, lines 26-28) and is provided with indicia (page 4, lines 27-29) to decorate the contoured surface area of the body that is covered with the pad **10** (page 4, lines 4-7). A peel sheet **18** (FIG. 18, page 4, line 4) is laid over the adhesive on the top surface **12** of the pad **10**, until the pad **10**, is ready to be applied to the desired body part.

## **VI. ISSUES**

- A. Whether claims 21-23, 29 and 32 are unpatentable under 35 U.S.C. § 102 (b) as being anticipated by Yonkers (U.S. 3,985,383).
- B. Whether claim 27 is unpatentable under 35 U.S.C. § 103 (a) over Yonkers (US 3,985,383) in view of Lee (US 6,613,382).

## **VII. GROUPING OF THE CLAIMS**

- A. Independent claim 21 is directed to a novelty fashion wear item having its entire upper surface coated with an adhesive material and a non-slip lower surface provided with decorative indicia.
- B. Independent claim 22 is directed to a method of decorating a body part with a decorative fashion wear item having its entire upper surface coated with an adhesive material and a non-slip lower surface provided with decorative indicia.
- C. Independent claim 23 and its dependent claim 29 and 32 are directed to a fashion wear item comprised of a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces and a peelable material covering the non-skin irritating adhesive to protect the adhesive material until it is ready for use.
- D. Dependent claim 27 is directed to a fashion wear item comprised of a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of



another one of its surfaces and a peelable material covering the non-skin irritating adhesive to protect the adhesive material unit it is ready for use. The decorative indicia is screen printed on the non-skid pad.

## **VIII. ARGUMENTS**

Before presenting Appellants argument, the following comment is provided for the consideration of the Board:

The point for decision in this case is whether a thin, flexible pad, such as claimed in claim 23, provided with adhesive on one of its surfaces for affixation to a particular group of body parts that are normally subject to abrasion, formed to serve as a substitute for an active-wear covering such as shoes, gloves, knee shin and elbow pads, especially when they are also provided with decoration on the exposed side, would be anticipated by the Yonkers reference cited by the examiner, which is a two piece device for indexing sheets of paper or other planar objects. There are good reasons for finding that the Yonkers reference does not anticipate the disclosed invention under appeal.

For example, appellant's invention provides a solution to a long felt need. That is, many active people, young and old, would like to go barefoot, but instead hesitate for fear of burning their feet on hot sands, hot pavement, hot concrete, etc. . and injuring their feet on dirt, gravel and stones. Along with barefoot freedom, people like to have fun. Appellant's invention provides a double dose of fun to the users- the appearance and feeling of going barefoot, all without risk, plus the fun of exhibiting artwork on the soles of their feet. (See the enclosed photograph copies showing the claimed invention as provided in Section X of this appeal brief). The prior art device as disclosed by the Yonkers reference has certain characteristics that teach away from appellant's invention and thus the Yonkers reference does not anticipate appellant's invention. For example, the two piece indexing device of the Yonkers reference certainly is helpful when working to index or separate stacks of planar sheets of paper, but such a device does not suggest fun, which is the spirit of appellant's invention. The Yonkers

reference discloses a device with a clunky structure, interposing a thick mass of traction material between the user's foot and the ground would be like walking on a small stone or pebble, which certainly does not suggest lightness, carefree movement, and freedom.

The idea of a total package of utility, fun and appearance is important because users want comfort, they want design and they want to be "in". To applicant's knowledge, there is only one shoe that is currently available for use in the water of the beach and pool – a conventional type of shoe known as the aqua shoe or beach sock. Young people, especially kids, tweens and teens think these shoes are ugly and are embarrassed to wear them. They will bear the pain of burning feet and pokes and scratches rather than (in their view) look like a "nerd" wearing an aqua shoe. Traditional thongs, sandals and the like cannot be worn in the pool or in the ocean, but appellant's inventive product is ideal for this purpose. In this regard, the pad is not visible unless the wearer chooses to show the artwork on the bottom of his or her foot. Applicant's invention provides a product that is fashionable, convenient to apply, fun to wear and use, and users, young and old will embrace the concept.

With all of the above advantages and meeting and satisfying a felt need, appellant's invention would have been brought to the public's attention long ago if it was anticipated or obvious to one skilled in the art.

#### **VIIIA. REJECTION OF CLAIMS 21-23, 29 AND 32 UNDER 35 USC §102(b)**

##### **1. Claim 21:**

In the Office action dated October 3, 2003, (a copy of which is enclosed in Section X of this appeal brief) the examiner rejected claims 21 under 35 U.S.C. 102 (b) as being anticipated by ***Yonkers (US 3,985,383)*** a copy of which is enclosed in Section X of this appeal brief.

Claim 21 as presented for examination provides:

"21. A novelty fashion wear item, comprising:

a flexible pad having an upper surface and  
a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform  
to a contoured surface area of a body part;

said pad having its entire upper surface coated  
with an adhesive material for removably securing  
said pad to said contoured surface area of a body  
part to facilitate decorating said contoured surface  
area; and

said pad having its lower surface provided with  
indicia to decorate said contoured surface area."

Nowhere is this combination of elements described in, nor suggested by the  
***Yonkers reference***.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." ***RCA Corp. v. Applied Digital Data Sys., Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), ***cert. dismissed***, 468 U.S. 1228 (1984), ***citing Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), ***cert. denied***, 465 U.S. 1026 (1984). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" ***In re Robertson***, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) ***citing Continental Can Co. v. Monsanto Co.***, 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 USPQ2d at 1749 (*quoting In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

The Examiner's rejection of claim 21 is based on the ***Yonkers reference (US 3,985,383)***, which fails to show all of the essential elements of the instant invention. In this regard, the ***Yonkers reference (US 3,985,383)*** describes an indexing or separating device **10** (FIGS 1-4, and Column 2, lines 48-54) for indexing or separating adjacent planar objects, such as sheets of paper (Column 2, lines 3-5 ) and not a novelty fashion wear item.

The ***Yonkers reference (US 3,985,383)*** describes the indexing device **10** as a multi-element device, which includes two primary elements (See FIGS. 4-5):

- a. A layer of plastic film **14**; and
- b. A mass of traction material **18**.

More specifically, the ***Yonkers reference (US 3,985,383)*** provides that the layer of plastic film **14** (FIG. 4, Column 2, line 55-56) may be formed in any desired configuration (FIGS. 4-6, Column 2, line 56 and Column 4, lines 10-19). The plastic film **14** has an upper surface **19** and a bottom surface **15**, where the bottom surface **15** is coated with a pressure sensitive adhesive material **16** (FIG. 4) that enables the layer of plastic film **14** to be attached to the finger **11** of a user (Column 2, line 66 to Column 3, line 13).

The ***Yonkers reference*** further discloses that the layer of plastic film **14** is flexible so as to conform easily to the contour of the finger **11**, or in the alternative, it is rigid to serve not only as a support element but also as protection against punctures caused by the objects being indexed or separated (Column 2, lines 59-65).

The ***Yonkers reference*** also teaches that the upper surface **19** of the plastic film **14** is coated with a layer of cement that secures a mass of traction material **18** (FIG. 4) to the upper surface **19**. The mass of traction material **18** has a very high coefficient of friction with respect to the objects to be indexed and is composed of an elastomeric material such as foam and sponge rubber

containing glycerine; or in an alternative embodiment, the mass of traction material **18** may be smooth rubber stock that has been cross-cut or hatched to increase its traction capability or rubber threads which have been released from a liquid rubber container onto the plastic layer of film **14**. (Column 3, lines 18-29).

Turning now to the comments of the examiner:

The examiner, in the Office Action of October 3, 2003 stated, "Yonkers provides a flexible pad having an upper surface and a lower surface with a non-slip texture" referencing (FIG. 4, identifier 18: column 2, lines 15-23 of the *Yonkers reference*). In this regard, FIG. 4 in the *Yonkers reference* illustrates the indexing device **10** showing that it has a first side or surface **15** and a second side or surface **19**. The reference character **18** identifies the mass of traction material **18** that has been cemented to surface **19**. The text referenced by the examiner at column 2, lines 15-23 provides:

" Preferably, a mass of traction material is disposed on the other side of the layer of film in substantially the same configuration as the layer of film, but of a lesser cross-sectional area. Advantageously, the indexing device is removably mounted on a continuous strip of backing material and is simply removed from the backing material and placed on a finger or similar object for use in indexing objects."

As noted earlier, it is the mass of traction material **18** that has a non-slip texture and not the film **14**. FIG. 18 of the application under appeal illustrates a pad **10** having a first surface **12** and a second surface **13**. The text of the application provides at page 4, last full paragraph the following:

"Bottom surface 13 is intended for contacting the ground during use. It is preferred **that bottom surface 13 is waterproof or water resistant and is further provided with a non-slip texture.** " (Emphasis added)

The word "texture" as defined in "The Random House College Dictionary" Unabridged Edition means: "1. the characteristic structure of the interwoven or intertwined threads, strands, or the like, that make up a textile fabric; 2. the characteristic physical structure given to a material; 3. an essential part or quality; essence." It is clear from FIG. 18 in the application (since nothing is

shown attached to the bottom surface) as well as the definition of the word “texture” given the context in which the word is utilized in appellant’s patent application, that “texture” refers to the bottom surface texture of pad 10 and not something that has been attached to the bottom surface of pad 10, such as “a mass of traction material” as is shown in the *Yonkers reference*.

To further distinguish the present invention from the *Yonkers reference* page 3, lines 23- 25 of the application provides:

“As shown in Figs. 1 and 2, pad 10 is of **single piece construction** and adhesively covers the entire undersurface of foot 1. Pad 10 is relatively thin and made to conform to the shape of the foot bottom, including toes 2.” (Emphasis added)

The emphasized language from the application makes it clear that in the context of claim 21, that the “non-slip texture” is referring to the texture of the pad 10 and not an external element.

In summary then, the novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest, “a flexible pad having ... a lower surface with a non-slip texture...” Instead, the *Yonkers reference* discloses that the plastic film **14** has one of its surfaces **15** coated with an adhesive for securing the plastic film **14** to the finger of a user and that the other one of its surfaces **19** has secured thereto the mass of traction material **18**. (See Column 3, lines 14-21, of the *Yonkers reference* which provides: “In accordance with a further important feature of the present invention, a mass of traction material **18** having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface of the film **14**. The mass of traction material **18** may be of the same general configuration as the layer of plastic film **14** and may be attached thereto by cement.” In short then, the plastic film **14** does not have the non-slip texture; instead, the non-slip surface is provided by the mass of traction material **18**, which is adhered to the surface of the film **14**.

Since the *Yonkers reference* does not disclose, nor suggest, “a flexible pad having ... a lower surface with a non-slip texture...” this feature alone patentably distinguishes the present invention over the *Yonkers reference*.

Finally, the *Yonkers reference* does not teach nor disclose, “said pad having its lower surface provided with indicia to decorate said contoured surface area.” As noted immediately above, the *Yonkers reference* discloses that the plastic film **14** has one of its surfaces coated with an adhesive for securing the plastic film **14** to the finger of a user and that the other one of its surfaces has secured thereto the mass of traction material **18**. (See Column 3, lines 14-21, of the *Yonkers reference*). In this regard, the *Yonkers reference* teaches that both surfaces of the plastic film **14** are coated with an adhesive material or cement; one surface **15** is coated with an adhesive **16** to secure the plastic film **14** to the finger of the user, while the other surface **19** is coated with cement to secure the mass of traction material **18** to the plastic material **14**. (See Column 3, lines 18-21, which provided: “The mass of traction material **18** may be of the same general configuration as the layer of plastic material **14** and may be attached thereto by cement.”) In short then, the plastic film **14** does not have “its lower surface provided with indicia to decorate said contoured surface area” but instead the surface of the plastic film **14** has adhesive disposed thereon for securing to that surface the mass of traction material **18**.

As the *Yonkers reference* fails to suggest or disclose, “said pad having its lower surface provided with indicia to decorate said contoured surface area”, this feature alone patentably distinguishes the present invention over the *Yonkers reference*.

## 2. Claim 22:

In the Office action dated October 3, 2003, (a copy of which is enclosed in Section X of this appeal brief) the examiner rejected claim 22 under 35 U.S.C. 102 (b) as being anticipated by *Yonkers (US*

**3,985,383**) a copy of which is enclosed in Section X of this appeal brief.

Claim 22 as presented for examination provides:

"22. A method of decorating a body part, comprising the steps of:

providing decorative fashion wear;  
said fashion wear including:

a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;

providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;

providing the lower surface with indicia to decorate the contoured surface area of the body part; and

applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes."

Nowhere is this combination of steps described in, nor suggested by the **Yonkers reference**.

The Examiner's rejection of claim 22 is based on the **Yonkers reference (US 3,985,383)**, which fails to show all of the essential steps of the instant invention. In this regard, the **Yonkers reference** does not disclose, nor suggest, "providing decorative fashion wear ..." Instead, the **Yonkers reference** discloses an indexing or separating device **10** (FIGS 1-4, and Column 2, lines 48-54) for indexing or separating adjacent planar objects, such as sheets of paper (Column 2, lines 3-5). Clearly, this is not decorative fashion wear. It is noted, that the **Yonkers reference** does provide with reference to FIG. 6, at Column 4, lines 10-20 the following:

"Further, alternate embodiments of the indexing device **10** include variations of color and shape (FIG. 6) of both the mass of traction material **18** and the layer of plastic film **14**. For example, the device **10** may be formed in the shape of a heart **22**, a square **24**, a clover **26** or a diamond **28**. Each



of these alternate embodiments of the device 10 is constructed in essentially the same manner as that set forth above with respect to the preferred embodiment and may be attached to continuous backing strip 20."

However, the **Yonkers reference** is completely silent as to purpose of the shape and colors which leads to only reasonable inference, which is that the color and shapes are nothing more than mere variations on the disclosed invention, which is an indexing device and not decorative fashion wear.

As the **Yonkers reference** fails to suggest or disclose, "providing decorative fashion wear", this step alone patentably distinguishes the present invention over the **Yonkers reference**.

Secondly, the **Yonkers reference** does not teach nor disclose, "said fashion wear including a flexible pad with a non-slip texture..." Instead, the **Yonkers reference** discloses that the plastic film 14 is merely "flexible so as to conform easily to the contour of the finger 11." In this regard, the Yonkers reference is completely silent as to the texture qualities of the plastic film 14.

As the **Yonkers reference** fails to suggest or disclose, "said fashion wear including a flexible pad with a non-slip texture.." this step alone patentably distinguishes the present invention over the **Yonkers reference**.

Finally, the **Yonkers reference** does not teach nor disclose, "providing the lower surface with indicia to decorate the contoured surface area of the body part...". Instead, the **Yonkers reference** teaches that surface 19 is provided with cement. (FIG. 4, Column 2, lines 18-21) which is utilized to adhere the mass of traction material 18 thereto.

As the **Yonkers reference** fails to suggest or disclose, "providing the lower surface with indicia to decorate the contoured surface area of the body part;..", this step alone patentably distinguishes the present invention over the **Yonkers reference**.

### 3. Claim 23

In the Office action dated October 3, 2003, (a copy of which is enclosed in Section X of this appeal brief) the examiner rejected claim 23 under 35 U.S.C. 102 (b) as being anticipated by **Yonkers (US 3,985,383)**.

Claim 23 as presented for examination provided:

"23. A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces; and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part.

Nowhere is this combination of feature described in, nor suggested by the ***Yonkers reference***.

The Examiner's rejection of claim 23 is based on the ***Yonkers reference (US 3,985,383)***, which fails to show all of the essential features of the instant invention. In this regard, the ***Yonkers reference*** does not disclose, nor suggest, "a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces ..." Instead, the ***Yonkers reference*** discloses:

- 1) that one of its surfaces **15** "is coated with a pressure sensitive adhesive material **16** (FIG. 4) to enable the layer of plastic film **14** to be attached to the finger **11** or to another object" (See Column 2, line 68 to Column 3, line3); and
- 2) that "a mass of traction material **18** having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface **19** of the film **14**. " (See Column 3, lines 15-18).

Finally, the ***Yonkers reference*** does not teach nor disclose, "a non-slip pad having ...decorative indicia covering at least a portion of another one of its surfaces". Instead, the ***Yonkers reference*** teaches that surface **19** is provided with cement. (FIG. 4, Column 2, lines 18-21) which is utilized to adhere the mass of traction material **18** thereto.

As the **Yonkers reference** fails to suggest or disclose, “a non-slip pad having ...decorative indicia covering at least a portion of another one of its surfaces;..”, the absence of this feature alone patentably distinguishes the present invention over the **Yonkers reference**.

#### 4. Claim 29

In the Office action dated October 3, 2003, (a copy of which is enclosed in Section X of this appeal brief) the examiner rejected claim 29 under 35 U.S.C. 102 (b) as being anticipated by **Yonkers (US 3,985,383)**.

Claim 29 as presented for examination provided:

“29. The fashion wear item according to claim 23, wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected.”

The examiner in rejecting claim29 and its base claim 23 has stated, that the **Yonkers reference** discloses:

- 1) “The pad being flexible to conform to a contoured surface area of a body part , referencing figure 1, identifiers 10 and 11: column 2, lines 3-14;
- 2) “Yonkers provides a flexible pad having an upper surface and a lower surface with a non-slip texture, referencing figure 4, identifiers 18: column 2, lines 15-23).”

In short, the examiner has made reference to two separate components described in the **Yonkers reference**: 1) the film **14** which the **Yonkers reference** teaches is “flexible so as to conform easily to the contour of the finger 11” and 2) the mass of traction material **18**, “having a very high coefficient of friction”. The application under appeal specifically describes the invention as having a “single piece construction” (Page 3, line 23) and therefore the **Yonkers reference** teaches away from the disclosed invention since it is a two-piece construction. In this regard, the examiner cannot have it both ways, “a non-slip pad” and “a non-

slip pad that is sufficiently flexible to conform to the contour of user selected body parts". To anticipate the present invention the ***Yonkers reference*** would need to teach a single piece construction where the film 14 was not only sufficiently flexible to conform to the contour shape of a selected body part, but would also have a non-slip texture. The ***Yonkers reference*** does not teach such a single piece construction and therefore the Yonkers reference does not suggest nor disclose

"wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part...". Instead the ***Yonkers reference*** teaches that only the mass of traction material 18 has a non-slip texture and that only the film 14 is sufficiently flexible to conform to the shape of a finger tip 11.

As the ***Yonkers reference*** fails to suggest or disclose, "wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part...", the absence of this feature alone patentably distinguishes the present invention over the ***Yonkers reference***.

Finally there is nothing in the ***Yonkers reference*** that would indicate that the indexing device 10 would be suitable for use with other body parts "selected from the hands, feet, toes, knees and elbows of a user" since the device is an indexing device and the only body part disclosed is a finger tip 11. Certainly one could not conceive of indexing a stack of planar paper with one foot, toes, knee or elbow.

## 5. Claim 32

In the Office action dated October 3, 2003, (a copy of which is enclosed in Section X of this appeal brief) the examiner rejected claim 32 under 35 U.S.C. 102 (b) as being anticipated by ***Yonkers (US 3,985,383)***.

Claim 32 as presented for examination provided:

"32. The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements."

Claim 32 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would suggest that decorative indicia covers at least a portion of one of the surfaces of the layer of plastic film 14. More specifically, the *Yonkers reference* teaches that both surfaces of the plastic film 14 are covered with an adhesive material. One surface is covered with an adhesive material to enable the plastic film 14 to be attached to the finger of a user, and the other surface is coated with a cement material to enable the mass of traction material to be attached to the other surface. Therefore the *Yonkers reference* teaches away from decorative indicia covering at least a portion of another one of its surfaces, "wherein the decorative indicia is selected from an indicia group consisting of ...messages... and advertisements."

#### **VIIIB. REJECTION OF CLAIM 27 UNDER 35 USC §103(a)**

##### **1. Claim 27:**

In the Office action dated October 3, 2003, (a copy of which is enclosed in Section X of this appeal brief) the examiner rejected claims 27 under 35 U.S.C. 103 (a) over *Yonkers (US 3,985,383)* in view of *Lee (US 6,613,382)* copies of which are enclosed in Section X of this appeal brief.

Claim 27 as presented for examination provides:

"27. The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-skid pad."

In addition, the examiner has admitted that the *Yonkers reference* fails to teach decorative indicia being screen printed on the non-slip pad. In this regard, the examiner cites the *Lee reference* at Column 3, lines 39-48 for screen printing on a non-slip surface. The *Lee reference* at Column 3, lines 39-48 provides the following:

“As shown in FIG. 1, the plurality of note posters 10 are manufactured from a printed medium 20 having a printed surface 22 and an opposing adhesive surface 24. The printed medium 20 is preferably a planar vinyl sheet 20, although equivalent materials such as plastic, paper, and other materials are also acceptable and within the scope of the claimed invention. A plurality of images 26 are printed upon the printed surface 22 using printing techniques, such as screen printing, that are well known in the art. “

It is clear that the Lee reference teaches screen printing on only a planar sheet and not a non-slip texture as taught by the present invention. In this regard, the application under appeal provides in pertinent part: “The bottom surface 13 is decorated for viewing by third parties who will see the decoration as a fashion item, e.g., sandal, glove, or knee cover. The decoration may be color, pattern, text, advertising, relief design and texture, and combinations thereof. A presently preferred mode is screen printed on EVA.” (Page 4, lines 3-7). The claim language of claim 27 and its base claim 23 clearly limit the screen-printing to “a flexible pad with a non-slip texture”, and neither the **Yonkers reference** alone nor the **Lee reference** alone or in combination with the **Yonkers reference**, teaches or discloses, “ wherein the decorative indicia is screen printed on said non-skid pad...”.

Based on the foregoing, claim 27 patentably distinguishes over the **Yonkers reference** in view of the **Lee reference** under the same rationale as claim 23. Moreover, claim 27 patentably distinguishes of the **Yonkers reference** in view of the **Lee reference** since neither of the references whether taken alone or in combination teaches or discloses, “ wherein the decorative indicia is screen printed on said non-skid pad...”.

Finally, it should be noted by the Board, that the present application was filed on July 20, 2001, as a continuation-in-part of provisional application, U.S. Serial No.: 60,220,357 filed on July 24,2000. In this regard, the present application claimed the benefit of the filing date of the earlier provisional application. (See Official Filing receipt with confirmation No. 2605 enclosed in

Section IX herewith this appeal brief.) Thus, since the *Lee reference* issued on September 2, 2003, and was filed on December 22, 2000, *the Lee reference* should never have been presented as a proper prior art reference.

### **C. CONCLUSION**

In view of the arguments made in this Appeal Brief, the Board is therefore requested to reverse each of the rejections imposed by the examiner relative to the claims now pending before the Board.

### **1X. APPENDIX OF CLAIMS**

Claim 1 (Cancelled)

Claims 2-4 (Withdrawn)

Claims 5-6 (Cancelled)

Claims 7-9 (Withdrawn)

Claims 10-11 (Cancelled)

Claims 12-20 (Withdrawn)

Claim 21 (Currently Pending Before the Board) A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area of a body part;

said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area; and

said pad having its lower surface provided with indicia to decorate said contoured surface area.

22. (Currently Pending Before the Board) A method of decorating a body part, comprising the steps of:

providing decorative fashion wear;

said fashion wear including:

a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;

providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;

providing the lower surface with indicia to decorate the contoured surface area of the body part; and

applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes.

23. (Currently Pending Before the Board) A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces; and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part.

Claims 24-26 (Cancelled)

Claim 27 (Currently Pending Before the Board) The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-skid pad.

Claim 28 (Cancelled)

Claim 29 (Currently Pending Before the Board) The fashion wear item according to claim 23, wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected.

Claims 30-31 (Cancelled)

Claim 32 (Currently Pending Before the Board) The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements.

Claim 33 (Cancelled)

Claim 34 (Withdrawn)



Claims 35-41 (Cancelled)

Claims 42-43 (Withdrawn)

Claim 44 (Cancelled)

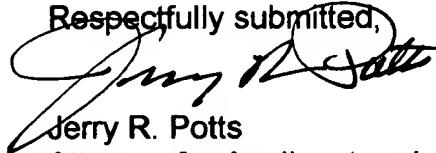
Claim 45-46 (Withdrawn)

**X. OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE**

- A. OFFICE ACTION OF OCTOBER 3, 2003 – FINAL REJECTION
- B. AMENDMENT AFTER FINAL REJECTION FILED  
NOVEMBER 8, 2003
- C. ADVISORY ACTION COMMUNICATED DECEMBER 2, 2003
- D. YONKERS US 3,985,383
- E. LEE US 6,613,382
- F. OFFICIAL FILING RECEIPT FOR APPLICATION 09/910,641

1-2-03

Respectfully submitted,



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,641	07/20/2001	Perriann M. Holden	1827-U-01 CIP	2605
33651	7590	10/03/2003	EXAMINER	
JERRY RICHARD POTTS 3248 VIA RIBERA ESCONDIDO, CA 92029			HOEY, ALISSA L	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,641

Applicant(s)

HOLDEN, PERRIANN M.

Examiner

Alissa L. Hoey

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-10, 12-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 7-9, 12-20, 34, 42, 43, 45 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 10, 21-32, 35-41 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The indicated allowability of claims 4,5,9 and 10 in paper No. 11, mailed October 29, 2002, is withdrawn in view of the rejections set forth below.
2. Amendment D, paper No. 14, filed February 7, 2003 and Amendment E, paper No. 18, filed August 18, 200 have been entered for purposes of this Office Action.

***Election/Restrictions***

3. This application contains claims directed to the following patentably distinct species of the claimed invention: a trimable foot pad and a preformed protector coupled to a pad.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Jerry Potts on 09/23/03 a provisional election was made with traverse to prosecute the invention of the trimable pad, claims 1, 5, 10, 21-32, 35-41 and 44. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-4, 6-9, 11-20, 33, 34, 42 and 43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 5 defines the invention as presently claimed as a kit having "a decoration to be applied to said bottom surface." As best

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understood, this required part of the kit sets forth a separate part of a decoration, which is to be applied to the bottom surface, when worn of the protective pad. The specification as originally filed provides a pad that is trimable and has a bottom surface layer that is decorated with a design. (See page 4, lines 4-8). There is no disclosure presented in the originally filed application to offer support for the claims as presently filed. Claim 10 requires that the method as presently claimed provide "decoration selected from at least one of the groups comprising color, pattern, graphic design, text, advertising, relief design and texture" in addition to a trimable pad with adhesive with a pealable film. The specification requires that the decoration be applied to the bottom surface of the pad. As presently claimed it could be applied to the adhesive, the second surface or the pealable film. Additionally claim 10 suggests, as best understood, that the pad is not only attached to a body part but to either a number of particular materials (claim 10). There is no disclosure presented in the originally filed application to offer support for the claims as presently filed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 10 fails to correspond in scope with that which applicant regards as the invention can be found in Paper No. 7 filed May 20, 2002. In that paper, applicant has stated that the pad is decorated and applied directly to the wearers body (see page5 through page 7 of Applicant's arguments), and this statement indicates that the invention is different

from what is defined in the claim(s) because the present invention alludes to the pad having a decorated side, an adhesive side and where the adhesive side has a removable cover which can be applied to the user's body or to a separate pre-formed cupped pad or material selected from a particular group as recited in claim 10.

9. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is questioned if the claim is an incompletely written method claim failing to suggest that the material of the protective pad be found in the particular material or shape or that the pad be attachable not only to the wearer's body, but to the particular material or shape.

#### ***Claim Objections***

10. Claim 26 is objected to because of the following informalities: it seems claim 26 is not fully finished, since it ends in "a layer of acrylate adhesive on one of its.". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 21-24, 29, 30, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yonkers (US 3,985,383).

Yonkers provides a flexible pad having an upper surface and a lower surface with a non-slip texture (figure 4, identifiers 18: column 2, lines 15-23). The pad being flexible to conform to a contoured surface area of a body part (figure 1, identifiers 10 and 11: column 2, lines 3-14). The pad having its entire upper surface coated with an adhesive material for removably securing the pad to the body part to facilitate decorating (figure 4, identifier 16: column 2, lines 66-68 through column 3, lines 1-13). The decorative indicia is chosen from colors and shapes (figure 6, identifiers 22, 24, 26 and 28: column 4, lines 10-19). The pad having its lower surface provided with indicia to decorate the contoured surface area (column 4, lines 10-19). A peelable material covering the adhesive to protect the adhesive material until ready for use (figure 5, identifier 20: column 4, lines 3-9). The non skid pad has sufficient thickness to protect the contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface (column 3, lines 14-29). The flexible pad conforms to the user's fingers and is made out of foam and sponge rubber (column 3, lines 14-50). The non-skid pad of Yonkers is capable of being trimmed and disposed of after use. Additionally, it is inherent that the adhesive of Yonkers is non-skin irritating (column 1, lines 66-68 through column 2, lines 1-2). Further, Yonkers teaches the method of providing a decorative pad with a non-slip texture to the finger of a user (column 1, lines 66-68 through column 2, lines 1-2).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



Art Unit: 3765

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers in view of Gamble et al (US 6,440,526).

Yonkers provides a non-slip decorative pad as described above in claims 23 and 24. However, Yonkers fails to teach the pad made out of ethylene vinyl acetate having a thickness of one sixteenth of an inch. Gamble et al. provides a non-slip pad with adhesive made out of ethylene vinyl acetate (column 4, lines 14-34).

With respect to the limitation that the pad has a thickness of one sixteenth of an inch. The specification contains no disclosure of either the critical nature of the claimed dimension or any unexpected results arising therefrom, and that as such the thickness of the pad being one sixteenth of an inch is arbitrary and therefore obvious. Such unsupported dimensions cannot be a basis for patentability, since where patentability is said to be based upon a particular dimension or another variable in the claim, the applicant must show that the pad being one sixteenth of an inch is critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal dimension for a particular application.

It would have been obvious to have provided the pad of Yonkers with the ethylene vinyl acetate material of Gamble et al., since the pad of Yonkers made out of ethylene vinyl acetate material would provide a pad that efficiently absorbs shock and who's surface can be easily modified as desired and embossed.

15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers in view of Muchin (US 5,718,224).

Yonkers provides a non slip pad as described above in claims 23 and 24. However, Yonkers fails to teach the adhesive material being acrylate polyurethane tape having a thickness of 1.2 millimeters. Muchin provides a pad having an adhesive material made out of acrylate polyurethane tape (column 3, lines 35-40).

With respect to the limitation that the pad has a thickness of 1.2 millimeters. The specification contains no disclosure of either the critical nature of the claimed dimension or any unexpected results arising therefrom, and that as such the thickness of the pad being 1.2 millimeters is arbitrary and therefore obvious. Such unsupported dimensions cannot be a basis for patentability, since where patentability is said to be based upon a particular dimension or another variable in the claim, the applicant must show that the pad being 1.2 millimeters is critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal dimension for a particular application.

It would have been obvious to have provided the pad of Yonkers with the acrylate polyurethane tape of Muchin, since the pad of Yonkers having it's adhesive made out of acrylate polyurethane tape material would provide a pad that has adhesive material that is reusable and has a elastic properties to conform to the user's skin surface better and is more comfortable to the user.

16. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers in view of Lee (US 6,613,382).

Yonkers provides a non slip pad as described above in claim 23. However, Yonkers fails to teach the decorative indicia being screen printed on the non slip pad. Lee provides a vinyl sheet having a printed surface and an adhesive surface, the printed surface is applied to the sheet by screen printing (column 3, lines 39-48).

It would have been obvious to have provided the non slip pad of Yonkers with the screen printed decorative indicia of Lee, since screen printing a decoration, color or design on a non slip surface is a way to provide decorative means to a adhesive article for aesthetic purposes.

17. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers and Gamble et al. in view of Lee.

Yonkers and Gamble et al. provide a non slip pad as described above in claim 25. However, Yonkers and Gamble et al. fail to teach the pad of ethylene vinyl acetate being provide with screen printing. Lee provides a vinyl sheet having a printed surface and an adhesive surface, the printed surface is applied to the sheet by screen printing (column 3, lines 39-48).

It would have been obvious to have provided the non slip pad of Yonkers and Gamble et al. with the screen printed decorative indicia of Lee, since screen printing a decoration, color or design on a non slip surface is a way to provide decorative means to pad of ethylene vinyl acetate for aesthetic purposes.

#### ***Response to Arguments***

18. Applicant's arguments with respect to claims 1-5, 7-10, 12-32 and 34-46 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rightmire, Stewart, Scholl, Scott, Loebeck, Spence, Jacob, Heinecke et al., Carver, Powell, Porcelli, Levy, Gochanour, Kypreos, Kluesner, Apple, Young, Ohira et al., O'Donnell et al., Cline et al., Cao, Lorkovic, Bonacci, Sullivan, Cavanagh et al. are cited to show closely related articles.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

alh



JOHN J. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Perriann M. Holden	)	Art Unit: 3765
	)	
Serial No.: 09/910,641	)	Attorney
	)	Docket No.: 810101-1
Filed: July 20, 2001	)	
	)	
Title: Protective Attachment	)	
	)	
	)	

**AMENDMENT AFTER FINAL REJECTION**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Attention: **Alissa Hoey**  
Examiner  
(703) 308-6094

Dear Sir or Madam:

Responsive to the Office Action mailed October 3, 2003, and the Advisory Action mailed October 31, 2003 please amend the above-identified patent application as follows:

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
Mail Stop: AF  
P.O. Box 1450  
Alexandria, VA 22313-1450

on 11-8-03 (Date)

Typed or printed name of person signing this certificate: **JERRY R. POTTS**

Signature JS

**IN THE CLAIMS**

1. (Canceled)
2. (Canceled)
3. (Canceled)
4. (Canceled)
5. (Canceled)
6. (Previously canceled)
7. (Canceled)
8. (Canceled)
9. (Canceled)
10. (Canceled)
11. (Previously canceled)
12. (Canceled)
13. (Canceled)
14. (Canceled)
15. (Canceled)
16. (Canceled)
17. (Canceled)
18. (Canceled)
19. (Canceled)
20. (Canceled)

21. (Previously presented) A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;  
said pad being sufficiently flexible to conform to a contoured surface area of a  
body part;

said pad having its entire upper surface coated with an adhesive material for  
removably securing said pad to said contoured surface area of a body part to facilitate  
decorating said contoured surface area; and

said pad having its lower surface provided with indicia to decorate said contoured  
surface area.

22. (Previously presented) A method of decorating a body part, comprising the steps of:

providing decorative fashion wear;

said fashion wear including:

a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;

providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;

providing the lower surface with indicia to decorate the contoured surface area of the body part; and

applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes.

23. (Previously presented) A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces; and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part.

24. (Canceled)

25. (Canceled)

26. (Canceled)

27. (Original) The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-skid pad.

28. (Canceled)

29. (Original) The fashion wear item according to claim 23, wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected.

30. (Canceled)



31. (Canceled)

32. (Original) The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements.

33. (Previously canceled)

34. (Canceled)

35. (Canceled)

36. (Canceled)

37. (Canceled)

38. (Canceled)

39. (Canceled)

40. (Canceled)

41. (Canceled)

42. (Canceled)

43. (Canceled)

44. (Canceled)

45. (Canceled)

46. (Canceled)

### **REMARKS**

In response to the Office Action mailed October 3, 2003 and the Advisory Action mailed October 31, 2003, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to place the present application in condition for immediate allowance, claims 2-5, 7-10, 12-20, 24-26, 28, 30-31, and 34-46 have been canceled. ***No claim amendments are presented in this response, accordingly none of the claims pending in this case require new consideration or any further search.***

### **Election/Restrictions**

In response to the requirement to elect a single disclosed species for prosecution, applicant elects a single species as provided in claims 1, 5, 10, 21-32, 35-41, and 44. In view of this election, applicant has canceled without prejudice, the withdrawn claims 2-4, 7-9, 12-20, 34, 42-43, and 45-46.

### **Rejections Under 35 USC §102(b)**

Claims 21-23, 29 and 32 have been rejected under 35 USC §102(b), as being anticipated by ***Yonkers (US 3,985,383)***.

**Claim 21:** Claim 21 as previously amended patentable distinguishes over the ***Yonkers reference***. In this regard, claim 21 as previously amended specifies amongst other things, as follows:

"21. A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area of a body part;

said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area; and said pad having its lower surface provided with indicia to decorate said contoured surface area."

Nowhere is this combination of elements and steps described in, nor suggested by the *Yonkers reference*

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the *Yonkers reference*, which fails to show all of the essential elements of the instant invention.

The *Yonkers reference* describes an indexing or separating device not a fashion wear item that is embodied within a novelty kit. More specifically the *Yonkers reference* describes a layer of plastic film 14 that has an upper surface 19 and a bottom surface 15, where the bottom surface 15 is coated with a pressure sensitive adhesive material 16 that enables the layer of plastic film 14 to be attached to the finger 11 of a user. The *Yonkers reference* further discloses that the layer of plastic film 14 is flexible so as to conform easily to the contour of the finger 11, or in the alternatively, it is rigid to serve not only as a support element but also as protection against punctures caused by the objects being indexed or separated. With reference to the *Yonkers reference* teaching that the layer of plastic film 14 is a support element, the *Yonkers reference* further provides that the upper surface 19 is coated with a layer of cement that secures a mass of traction material 18 to the upper surface, where the mass of traction material 18 has a very high coefficient of friction with respect to the objects to be indexed and is composed of an elastomeric

material such as foam and sponge rubber containing glycerine; or in an alternative embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched to increase its traction capability or rubber threads which have been released from a liquid rubber container onto the plastic layer of film 14.

Turning now to the comments of the examiner relative to what is taught by the *Yonkers reference*:

1. Yonkers provides ...The pad having its lower surface provided with indicia to decorate the contoured surface area (column 4, lines 10-19). Column 4, lines 10-19 merely provide that "the indexing device 10 includes variations of color and shape (FIG. 6) of both the mass of traction material 18 and the layer of plastic film 14. For example, the device 10 may be formed in the shape of a heart 22, a square, a clover 26 or a diamond 28." In this case, there is no teaching or disclosure that the lower surface of the device 10 is "provided with indicia to decorate said contoured surface areas." Instead the *Yonkers reference* is teaching that the elements of the device 10: the layer of plastic material 14, and the mass of traction material 18 can have a color or can be shaped to a desired configuration. There is nothing however, to suggest that indicia in the form of advertisement or text is disposed on the lower surface; instead the *Yonkers reference* teaches away from this since the lower surface of the layer of plastic film 14 is coated with a cement to secure the mass of traction material 18 to its support element, the layer of plastic film 14.

2. That Yonkers provides.... the non skid pad has sufficient thickness to protect the contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface (column 3, lines 14-29). Column 3, lines 14-19 provides:

"In accordance with a further important feature of the present invention, a mass of traction material 18 having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface 19 of the film 14. The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement. The mass of traction material 18 may, in a specific embodiment, be an elastomeric material such as foam and sponge rubber containing glycerine; or in an alternate embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched (FIG. 3) to increase its traction

capability. The mass of traction material 18 may alternately comprise rubber threads which are released from a liquid rubber container onto the plastic layer of film 14."

There is nothing in this cited text that would suggest that thickness has been considered to protect the finger of a user when brought into engagement with the ground. This is obvious, since the *Yonkers reference* only discusses rigidity as a means for protecting the finger and moreover, the device 10 is not something that engages the ground for indexing purposes, but instead is an indexing device for separating adjacent planar objects, such as stacked sheets of paper. (See Column 2, lines 52-54). In this regard, there is nothing in the cited text that would suggest that the layer of plastic film 14 is a pad with a non slip texture.

3. The Yonkers reference provides.... The flexible pad conforms to the user's fingers and is made out of foam and sponge rubber (Column 2, lines 14-50). As quoted above, only the mass of traction material 18 is described as being composed of foam and sponge rubber. The "pad" as utilized in the context of the cited reference refers to the layer of plastic film 14. Therefore there is no teaching or suggestion in the *Yonkers reference* that the layer of plastic film 14 is made out of foam and sponge rubber.

4. That Yonkers provides.... The non-skid pad of Yonkers is capable of being trimmed and disposed of after use. Yonkers would seem to teach away from trimming the device 10 since the *Yonkers reference* teaches that "it is believed that the excellent adhesion of the layer of plastic film 14 to the finger 11 results from the extension of the outer periphery of the layer of plastic film 14 beyond the outer periphery of the mass of traction material 18, that is, the mass of traction material 18 has a smaller cross sectional area than the cross-sectional area of the layer of plastic film 14. Therefore if a user would trim the device to fit the finger of a small person, it could well result in a disruption of the desired cross-sectional relationship between the film 14 and the mass of traction material 18.

5. That Yonkers provides.... a method of providing a decorative pad with a non slip texture to the finger of a user (Column 1, lines 66-68 through column 2, lines 1-2.)

The cited text provides:

An additional object of the present invention is to provide a new and improved device for indexing or separating adjacent planar objects that is attractive in appearance and does not readily produce skin irritation."

There is nothing in this cited text to suggest that the film material 14 includes decorative indicia or that the film material 14 has a non slip texture.

### **Specific Claim Rejections**

**Claim 21:** Considering now the specific rejection of claim 21 in greater detail, the novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest "a flexible pad having an upper surface and a lower surface with a non-slip texture..." Instead the *Yonkers reference* teaches a flexible layer of plastic film 14 that serves as a support element for the mass of traction material 18, which material 18 has a very high coefficient of friction to facilitate separating adjacent planar objects, such as sheets of paper as illustrated in FIG. 2. In this regard, it is the mass of traction material 18 that has the non slip texture, not the layer of plastic film 14.

Secondly, the *Yonkers reference* does not teach, nor suggest, "removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area." Instead the *Yonkers reference* teaches that a layer of plastic film 14 is attached to the finger of a user wishing to index or separate adjacent planar objects 12, such as sheets of paper as illustrated in FIG. 2. (Col 2, lines 51-54). Moreover, the *Yonkers reference* teaches that the layer of plastic film 14 is a support element for the mass of traction material 18. In short, the plastic film 14 is not a platform for decorative indicia.

Finally, the novel features and steps of the present invention are not suggested, nor taught by the *Yonkers reference* in that the *Yonkers reference* does not suggest, nor teach "said pad having its lower surface provided with indicia to decorate said contoured

surface area." Instead, the *Yonkers reference* teaches the other surface of the film 14 is coated with a layer of cement (Col 3, lines 18-21) that secures to that surface the mass of traction material 18.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 21 as previously amended patentably distinguishes over the *Yonkers reference*.

**Claim 22:** Claim 22 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 22 as previously amended specifies amongst other things, as follows:

"22. A method of decorating a body part, comprising the steps of:  
 providing decorative fashion wear;  
 said fashion wear including:  
 a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;  
 providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;  
 providing the lower surface with indicia to decorate the contoured surface area of the body part; and  
 applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest "providing decorative fashion wear..." Instead, the *Yonkers reference* teaches an indexing device 10 not fashion wear.

Secondly, the *Yonkers reference* does not teach nor disclose "a flexible pad with a non-slip texture". Instead the *Yonkers reference* teaches a layer of plastic film 14 having affixed to one of its surfaces "a mass of traction material 18". In short, there is

nothing to suggest that the layer of plastic **14** has a non slip texture; instead it is the mass of traction material **18** that has the non-slip texture.

Thirdly, the *Yonkers reference* does not suggest nor disclose, "said pad having its lower surface provided with indicia to decorate said contoured surface area." Instead, the *Yonkers reference* teaches that both its upper and lower surfaces are coated with an adhesive material and that the device **10** is for indexing or separating adjacent planar objects not for decorating purposes.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 22 as previously amended patentably distinguishes the *Yonkers reference*.

**Claim 23** Claim 23 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 23 as originally filed specifies amongst other things, as follows:

"23. A fashion wear item, comprising:  
a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces....."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not teach nor disclose, "a non-slip pad..." Instead the *Yonkers reference* teaches a layer of plastic film **14** that function as a support element for a mass of traction material **18** that is affixed by cement to one of its surfaces.

Finally, the *Yonkers reference* does not suggest nor disclose "a non slip pad having ...decorative indicia covering at least a portion of another one of its surfaces..." Instead, the *Yonkers reference* teaches a layer of plastic film **14** having both of its surfaces coated with an adhesive material.



Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 23 as previously amended patentably distinguishes over the *Yonkers reference*.

**Claim 27:** Claim 27 depends from claim 23 as previously amended and accordingly patentably distinguishes over the *Yonkers reference* under the same rationale as claim 23. Therefore, claim 27 as originally filed patentably distinguishes over the *Yonkers reference*.

**Claim 29:** Claim 29 as originally filed patentable distinguishes over the *Yonkers reference*. In this regard, claim 29 as originally filed specifies amongst other things, as follows:

"29. The fashion wear item according to claim 23, wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected."

Claim 29 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would indicate that the indexing device 10 would be suitable for use with other body parts selected from the hands, feet, toes, knees and elbows of a user.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 29 as originally filed patentably distinguishes over the *Yonkers reference* under the same rationale as set forth earlier relative to claim 23 and as well as for the reasons given herein.

**Claim 32:** Claim 32 as originally filed patentable distinguishes over the *Yonkers reference*. In this regard, claim 32 as originally filed specifies amongst other things, as follows:

"32. The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements."

Claim 32 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would suggest that decorative indicia covers at least a portion of one of the surfaces of the layer of plastic film 14. More specifically, the *Yonkers reference* teaches that both surfaces of the plastic film 14 are covered with an adhesive material. One surface is covered with an adhesive material to enable the plastic film 14 to be attached to the finger of a user, and the other surface is coated with a cement material to enable the mass of traction material to be attached to the other surface. Therefore the *Yonkers reference* teaches away from decorative indicia covering at least a portion of another one of its surfaces, "wherein the decorative indicia is selected from an indicia group consisting of ...messages... and advertisements."

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 32 as originally filed patentably distinguishes over the *Yonkers reference*.

### **Rejections Under 35 USC §103**

**Claim 27:** Claim 27 has been rejected under 35 USC §103 as being unpatentable over *Yonkers* in view of *Lee* (US 6,613,382).

Claim 27 as originally filed patentably distinguishes over the *Yonkers reference in view of Lee (US 6,613,382)*. In this regard, claim 27 as originally filed specifies amongst other things, as follows:

"27. The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-skid pad.

The *Lee reference* discloses a method of manufacturing a plurality of note posters from a planar vinyl sheet having a printed surface and an opposing adhesive surface provides for first printing a plurality of images upon the printed surface.

The novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference in view of Lee* in that the cited references either alone or in combination fail to disclose or teach, "wherein the decorative indicia is screen printed on said non-skid pad." More particularly, the *Yonkers reference* teaches that the subject surface is coated with a cement to secure the mass traction material 18 to the surface of the layer of plastic 14. Therefore the *Yonkers reference* teaches away from printing on the surface of the plastic material 14 that is attached to the mass traction material 18. Accordingly, claim 27 as originally filed patentably distinguishes over the cited references for the reasons given as well as under the same rationale as set forth above with reference to claim 23.

#### **General Comment Relative to Advisory Action of October 31, 2003**

Attorney for Applicant has duly noted that the Supervisory Patent Examiner refused to enter the previous amendment filed on October 10, 2003, because the claim amendments require new consideration and search. However, many of the pending claims in the previous Amendment of October 10, 2003, were not amended in that response but had been amended previously (and entered for the purpose of the Office Action mailed on October 3, 2003) and specific arguments were presented in the October 10, 2003 response to distinguish these claims over the cited references. Notwithstanding this fact, the Supervisory Patent Examiner failed to address these claims in the Advisory Action of October 31, 2003. **Attorney for Applicant is bringing this oversight to the attention of the Supervisory Patent Examiner and Examiner Hoey to make certain that no further errors are made relative to claims 21-23, 27, 29 and 32, which claims in their present form were entered for examination purposes on October 3, 2003 as noted in paragraph 2 of that Office Action.**

#### **Conclusion**

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: November 8, 2003

respectfully submitted,

Jerry R. Potts & Associates

By



Jerry R. Potts  
Attorney for Applicant  
Registration No. 27,091  
(760) 822-6201

<b>Advisory Action</b>	Application No. 09/910,641	Applicant(s) HOLDEN, PERRIANN M.	
	Examiner Alissa L. Hoey	Art Unit 3765	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

THE REPLY FILED 14 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 21-23, 27, 29 and 32.

Claim(s) withdrawn from consideration: 1-20, 24-26, 28, 30, 31 and 33-46.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: See Continuation Sheet

Continuation of 10. Other: Claims 21-23, 29 and 32 stand rejected under 35 USC 102 (b) as anticipated by Yonkers (US 3,985,383) and claim 27 stands rejected under 35 USC 103(a) Yonkers in view of Lee (US 6,613,382).

[54] INDEXING DEVICE

[76] Inventor: John L. Yonkers, 2030 Sunset Ridge Road, Northbrook, Ill. 60062

[22] Filed: Mar. 3, 1975

[21] Appl. No.: 554,676

[52] U.S. Cl. .... 294/25; 2/21

[51] Int. Cl.<sup>2</sup> .... A41D 13/08; A61F 13/10

[58] Field of Search .... 294/1 R, 25; 2/21, 163; 15/227; 128/153, 157; 206/447, 460; 223/101; 273/81 B, 81 D, 166

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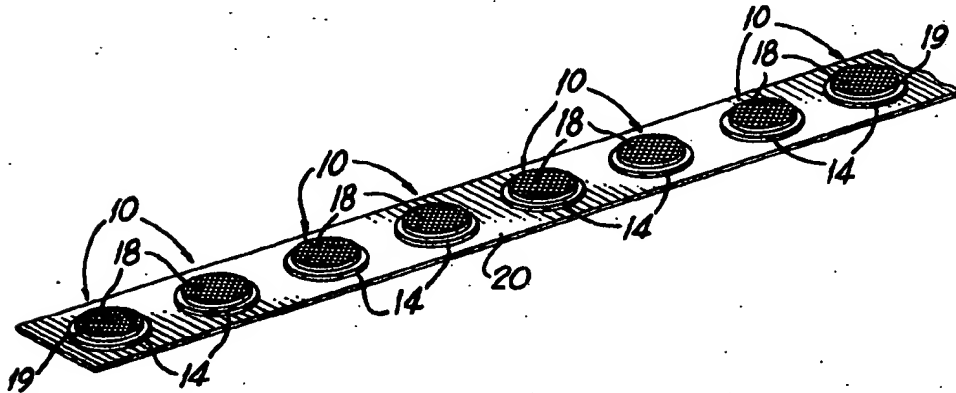
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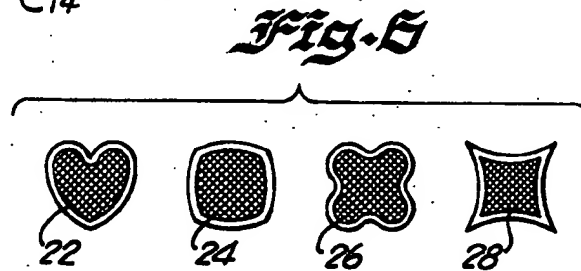
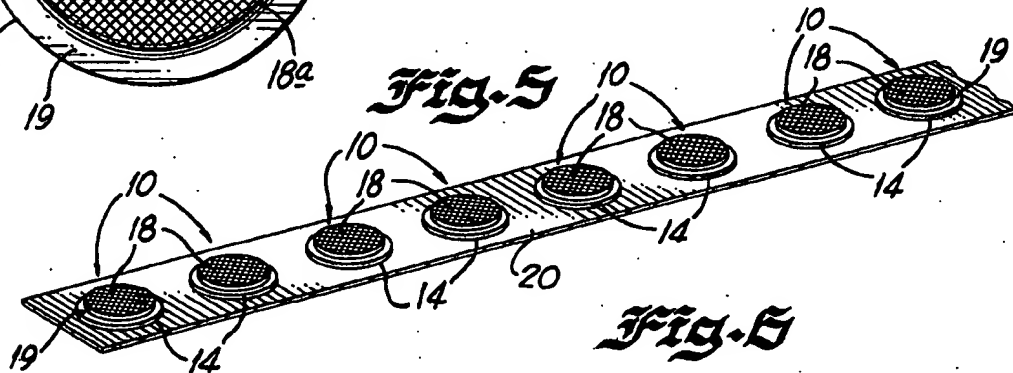
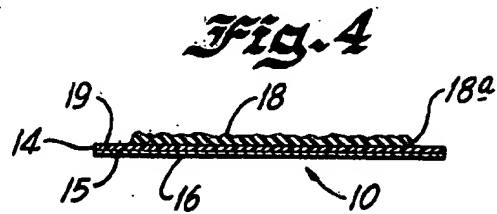
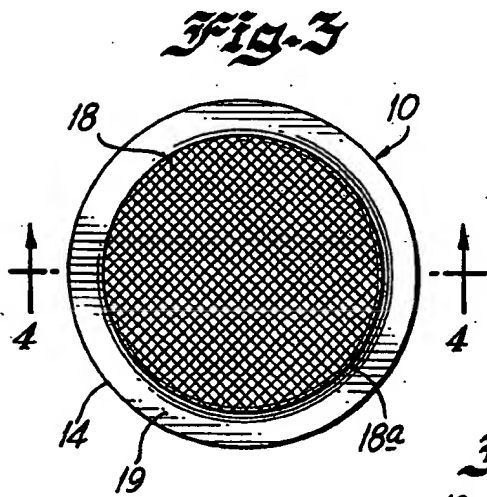
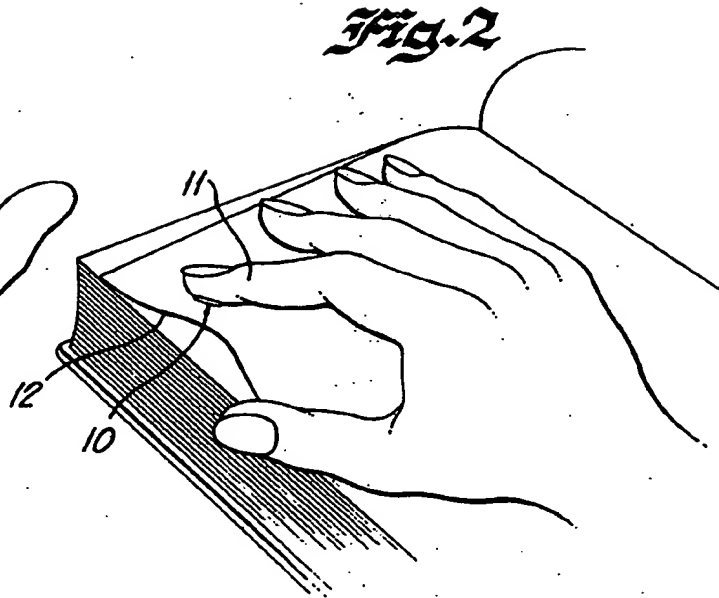
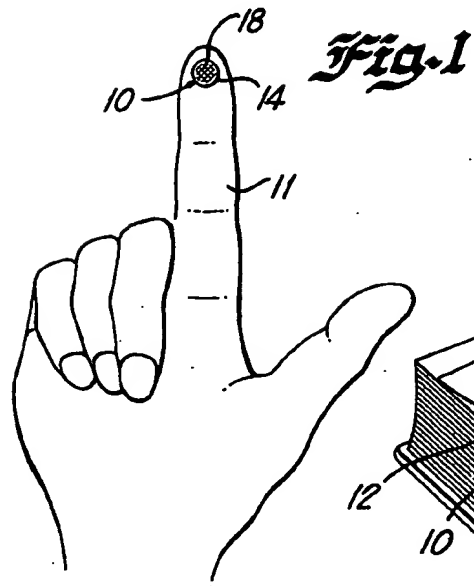
Primary Examiner—Johnny D. Cherry  
Attorney, Agent, or Firm—Mason, Kolehmainen

[57] ABSTRACT

An indexing device includes a layer of film and pressure sensitive adhesive material located on at least a portion of one side of the layer of film to enable the layer of film to adhere to an object such as a finger. The indexing device further includes material having a very high coefficient of friction with respect to the objects to be indexed disposed upon at least a portion of the second side of the film layer. By sliding the material disposed on the second side of the indexing device across a planar object such as a sheet of paper, a substantial frictional force is developed that resists the relative movement of the indexing device and the planar object. This resistance to relative movement serves to index or separate the planar object from adjacent planar objects.

4 Claims, 6 Drawing Figures







## INDEXING DEVICE

## BACKGROUND OF THE INVENTION

## 1. Field of the Invention

The apparatus of the present invention generally relates to a new and improved apparatus for indexing or separating adjacent planar objects and to a new and improved method for indexing or separating such planar objects and, more particularly, to a new and improved device and method for separating or indexing adjacent sheets of paper.

## 2. Description of the Prior Art

In the handling of papers in clerical and stenographic work, rubber shells, shaped like the end of a finger, are used to separate or index sheets of paper. These devices, though widely used throughout the business world, are characteristically unattractive in appearance, produce skin irritation in hot weather and become soiled with use. Such rubber shells are also extremely cumbersome to use because they must be removed by the user when a different task such as typing is commenced. Upon completion of this different task, a rubber shell must be replaced on the finger to allow the user to return to separating or indexing items, such as sheets of paper. As a result, the user is inconvenienced by the process of putting on and removing the rubber shell as the user changes from task to task.

Typically, prior art rubber shells are of the type formed from rubber or similar material having cross hatching around its entire periphery to increase its traction. This type of shell is formed in the shape of the end of a finger so that it may be worn over the tip of a user's finger. Since these prior art shells are placed over the tip of the finger, the entire shell is made of traction or rubber material even though all portions of the shell are not used against a workpiece at the same time. This configuration necessitates the use of a greater amount of traction material than is actually necessary, thereby increasing the cost of production. Moreover, the shape of the shell further increases the complexity of manufacturing and thus the cost of production.

Since the rubber shell covers the entire tip of the finger, little or no air is vented to the portion of the finger beneath the shell. This results in increased perspiration which attacks the traction material of the shell resulting in rapid deterioration. Additionally, the universal size of the rubber shell, which is necessitated by mass production, results in a loose fit on small fingers making them difficult to use, or a tight fit on large fingers causing discomfort and limiting the period of wear.

## SUMMARY OF THE INVENTION

An object of the present invention is to provide a new and improved device for indexing or separating adjacent planar objects.

Another object of the present invention is to provide a new and improved method for indexing or separating adjacent planar objects.

A further object of the present invention is to provide a new and improved device for indexing or separating adjacent planar objects in which the device need not be removed to perform other tasks.

An additional object of the present invention is to provide a new and improved device for indexing or separating adjacent planar objects that is attractive in

appearance and does not readily produce skin irritation.

Briefly, the present invention is directed to a new and improved device for indexing or separating adjacent planar objects, such as sheets of paper. This device is referred to as an indexing device and includes a layer of film which can be of several different configurations, but is of a size such that it may be easily placed on a finger tip. A pressure sensitive adhesive material that enables the layer of film to be securely mounted onto the tip of a finger or other object is disposed on one side of the layer of material. Since the indexing device is small and adheres to a fingertip, the user can alternate tasks without removing the device.

Preferably, a mass of traction material is disposed on the other side of the layer of film in substantially the same configuration as the layer of film, but of a lesser cross-sectional area. Advantageously, the indexing device is removably mounted onto a continuous strip of backing material and is simply removed from the backing material and placed on a finger or similar object for use in indexing objects.

## BRIEF DESCRIPTION OF THE DRAWING

The above and other objects and advantages and novel features of the present invention will become apparent from the following detailed description of a preferred embodiment of the invention illustrated in the accompanying drawing wherein:

FIG. 1 is an elevational view of a preferred embodiment of the indexing device constructed and used in accordance with the principles of the present invention;

FIG. 2 is an illustrative view of the manner in which the device of FIG. 1 may be used;

FIG. 3 is an enlarged top plan view of the device of FIG. 1;

FIG. 4 is an enlarged, cross-sectional view of the device of FIG. 1 taken along line 4—4 of FIG. 3;

FIG. 5 is an elevational view of a plurality of the devices of FIG. 1 mounted on a continuous backing strip; and

FIG. 6 is an enlarged elevational view of a plurality of alternate embodiments of the device of FIG. 1.

## DESCRIPTION OF THE PREFERRED EMBODIMENT

With reference to FIGS. 1-4 of the drawing, there is illustrated a new and improved indexing device 10 constructed in accordance with the principles of the present invention. The indexing device 10 may be attached to the finger 11 of an individual wishing to index or separate adjacent planar objects 12, such as sheets of paper, as illustrated in FIG. 2.

The indexing device 10 includes a layer of plastic film 14 which may be formed in any desired configuration, for example, in a preferred embodiment, it may have a circular outer periphery in the shape of a disc as illustrated in FIG. 3. The layer of plastic film 14 serves as the support element of the indexing device 10 and may be flexible so as to conform easily to the contour of the finger 11. Alternately, the layer of plastic film 14 may be rigid to serve not only as a support element but also as protection against punctures caused by the objects being indexed or separated.

In accordance with an important feature of the present invention, a first side or surface 15 of the layer of plastic film 14 is coated with a pressure sensitive adhesive

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sive material 16 (FIG. 4) to enable the layer of plastic film 14 to be attached to the finger 11 or to another object. Through the use of the adhesive material 16, no other supporting or attaching means is required during the use of the indexing device 10. The adhesive material 16 can be of any type well known in the art and may be of the same material as that used on ordinary adhesive tape. In addition, the adhesive material 16 may cover either a portion of the side 15 of the film 14 or the entire side 15 of the film 14 depending on the adhesive qualities of the material 16 and the desirability of securing the complete side 15 of the film 14 onto the finger 11.

In accordance with a further important feature of the present invention, a mass of traction material 18 having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface 19 of the film 14. The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement. The mass of traction material 18 may, in a specific embodiment, be an elastomeric material such as foam and sponge rubber containing glycerine; or, in an alternate embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched (FIG. 3) to increase its traction capability. The mass of traction material 18 may alternately comprise rubber threads which are released from a liquid rubber container onto the plastic layer of film 14.

It is believed that the excellent adhesion of the layer of plastic film 14 to the finger 11 results from the extension of the outer periphery of the layer of plastic film 14 beyond the outer periphery of the mass of traction material 18, that is, the mass of traction material 18 has a smaller cross-sectional area than the cross-sectional area of the layer of plastic film 14.

Further, it has been determined by experimentation that if the mass of traction material 18 is relatively thick, better adhesion to the finger 11 by the device 10 results if a peripheral edge 18a (FIG. 4) of the mass of traction material 18 is tapered.

A specific example of a preferred embodiment of the present invention is a layer of plastic film 14 formed in the shape of a disc and having a diameter of 5/16 inch. A mass of traction material 18 formed in the shape of a disc from foam and sponge rubber containing glycerine and having a diameter of 1/4 inch is secured to the side 19 of the layer of plastic film 14. In addition, pressure sensitive adhesive material 16 is disposed on the entire side 15 of the layer of plastic film 14.

Another embodiment of the indexing device 10 includes a layer of plastic film 14 which has a first side or surface 15 upon which adhesive material 16 is applied. The peripheral edge of the layer of plastic film 14 is tapered from its other or second side or surface 19 to its first side 15 such that the layer of plastic film 14 serves both as a support element for the adhesive material 16 and as a mass of traction material for indexing objects. The layer of plastic film 14 in this embodiment of the present invention has a frustoconical shape in which the side or surface 19 serves as the traction surface. The side or surface 19 may be cross-cut or

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hatched in a manner similar that shown in FIG. 3 to increase its traction capability.

A plurality of indexing devices 10 can be attached to a continuous backing strip 20 (FIG. 5) through the use of the adhesive material 16 and placed in dispensing containers such as those commonly used by adhesive tag manufacturers. When an indexing device 10 is to be used, it may be separated from the continuous backing strip 20 and placed on the finger 11.

Further, alternate embodiments of the indexing device 10 include variations of color and shape (FIG. 6) of both the mass of traction material 18 and the layer of plastic film 14. For example, the device 10 may be formed in the shape of a heart 22, a square 24, a clover 26 or a diamond 28. Each of these alternate embodiments of the device 10 is constructed in essentially the same manner as that set forth above with respect to the preferred embodiment and may be attached to a continuous backing strip 20.

Obviously, many modifications and variations of the present invention are possible in light of the above teachings. Thus, it is to be understood that, within the scope of the appended claims, the invention may be practiced otherwise than as specifically described above.

What is claimed and desired to be secured by Letters Patent of the United States is:

1. An indexing device comprising
  - a layer of film,
  - pressure sensitive adhesive material attached to a first side of said film, and
  - traction material attached to a second side of said film, said layer of film being more rigid than said traction material, said traction material being of a configuration slightly smaller than that of said layer of film such that an edge of said layer extends beyond the outer periphery of said traction material.
2. An indexing device as defined in claim 1 wherein said configuration of said film and said traction material comprises a substantially circular outer periphery.
3. An indexing device as defined in claim 2 wherein said traction material comprises sponge rubber containing glycerine.
4. An indexing device comprising a layer of film, traction material attached to a first side of said film, said layer of film being more rigid than said traction material, said traction material comprising a mass of elastomeric material having an upper and a lower surface and first and second pluralities of cuts disposed on said upper surface, said first plurality of cuts being disposed transverse to said second plurality of cuts, the outer periphery of said mass of said elastomeric material being tapered from said lower surface to said upper surface, the area of said lower surface being substantially greater than the area of said upper surface, said layer of film being attached to said lower surface and having a slightly larger area than the area of said lower surface such that a portion of said layer extends beyond the periphery of said mass, and pressure sensitive adhesive material attached to a second side of said film.

\* \* \* \* \*



US006613382B1

(12) **United States Patent**  
Lee

(10) Patent No.: **US 6,613,382 B1**  
(45) Date of Patent: **Sep. 2, 2003**

(54) **METHOD OF MANUFACTURING A NOTE POSTER**

(76) Inventor: **Eunchang Lee**, 21 Andalucia, Irvine, CA (US) 92614

(\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 283 days.

(21) Appl. No.: **09/746,926**

(22) Filed: **Dec. 22, 2000**

(51) Int. Cl.<sup>7</sup> ..... **B05D 5/10**

(52) U.S. Cl. .... **427/208; 427/208.4; 427/208.8; 427/209; 427/265; 427/289; 427/412.1; 427/430.1**

(58) Field of Search ..... **427/208, 208.4, 427/208.8, 209, 265, 289, 412.1, 430.1**

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4,039,134 A	8/1977	Redmer
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4,756,498 A	7/1988	Frye
4,783,354 A	11/1988	Fagan

5,046,696 A	9/1991	Lee
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5,110,077 A	5/1992	Mossini
5,121,896 A	6/1992	Frye
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D419,192 S	1/2000	Huang

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DE WO 97/01483 1/1997

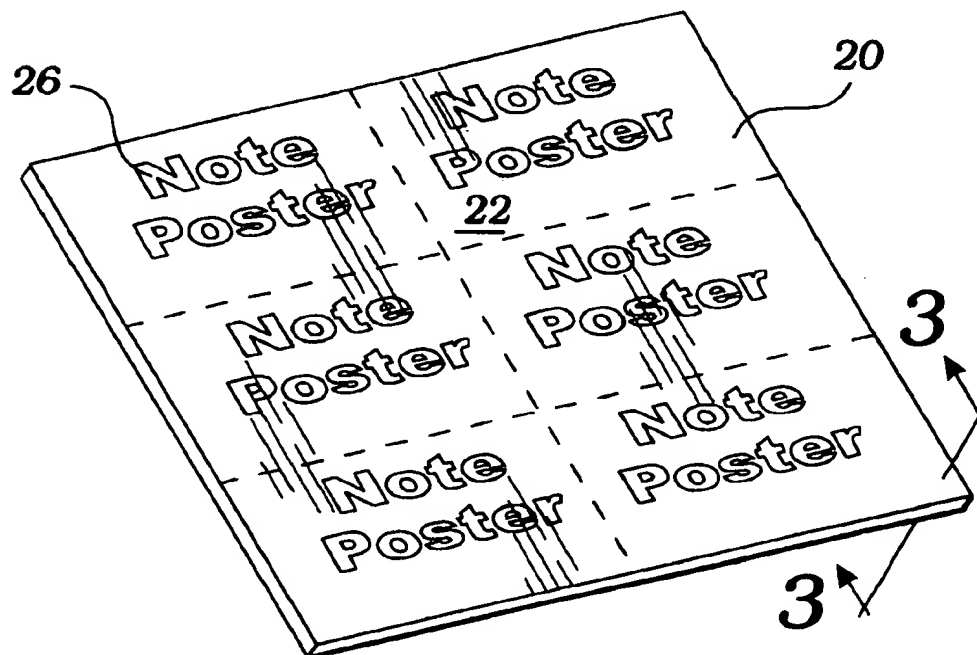
*Primary Examiner*—Bernard Pianalto

(74) *Attorney, Agent, or Firm*—Eric Karich

(57) **ABSTRACT**

A method of manufacturing a plurality of note posters from a planar vinyl sheet having a printed surface and an opposing adhesive surface provides for first printing a plurality of images upon the printed surface. Once it has been printed, the planar vinyl sheet is laid in a horizontal position with the adhesive surface facing upwards, and a liquid polymer adhesive is poured onto the adhesive surface such that the liquid polymer adhesive spreads across and evenly covers the planar vinyl sheet to form a polymer adhesive layer. The planar vinyl sheet is then die-cut around each of the plurality of images, thereby forming the plurality of note posters. The polymer adhesive layer forms a tacky surface on each of the plurality of note posters useful for removably securing a paper note to a surface.

**8 Claims, 2 Drawing Sheets**



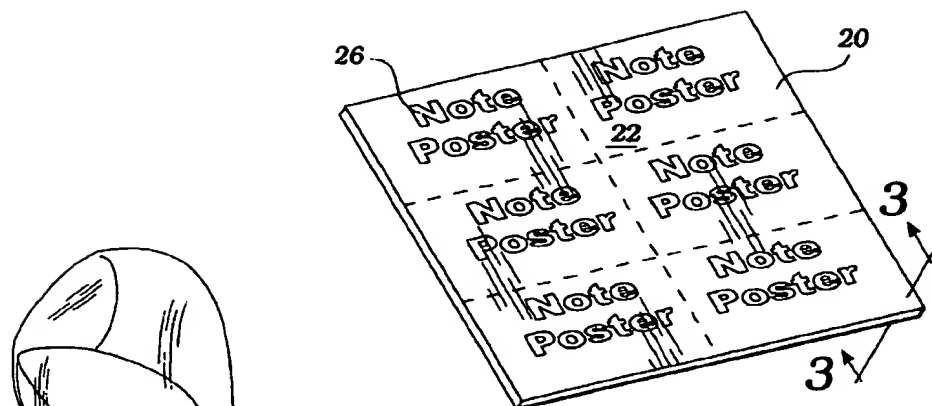


Fig. 1

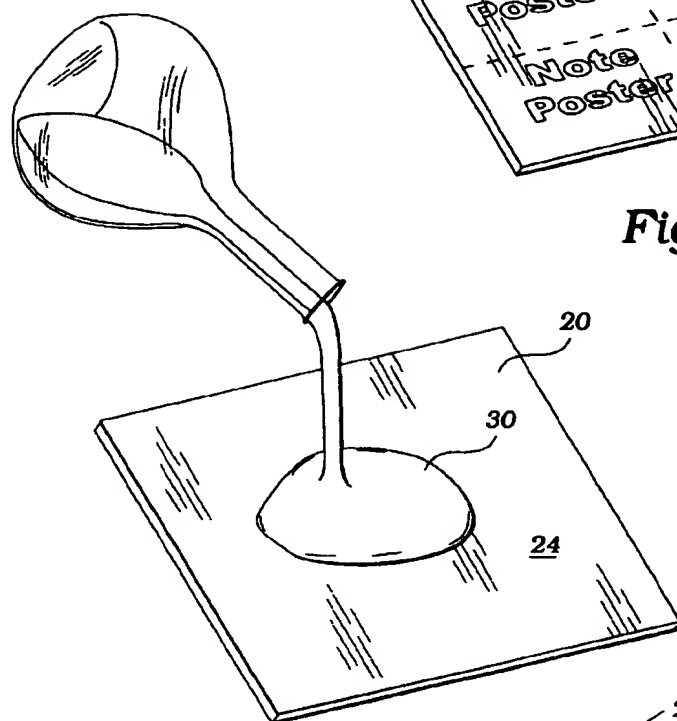


Fig. 2

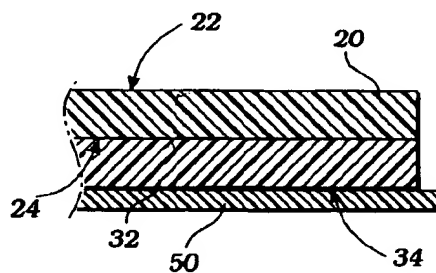


Fig. 3

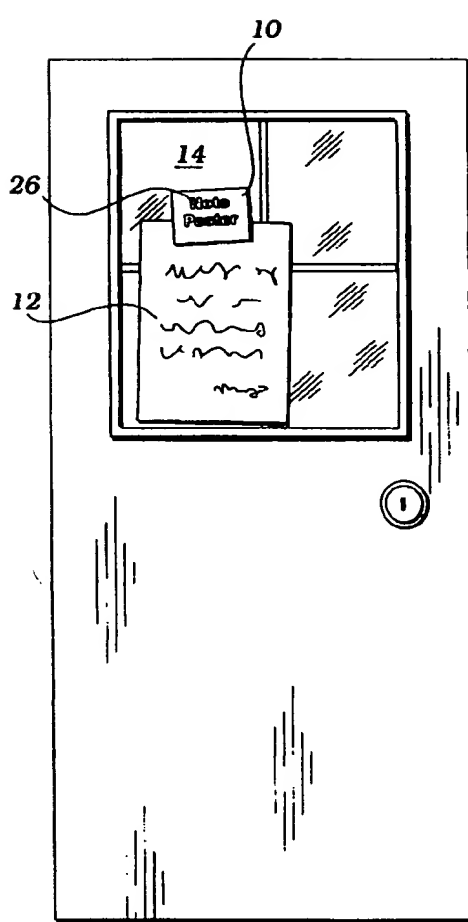


Fig. 4

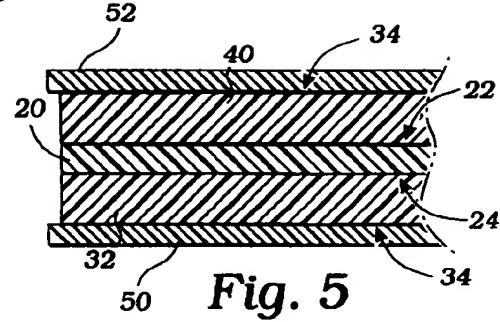


Fig. 5

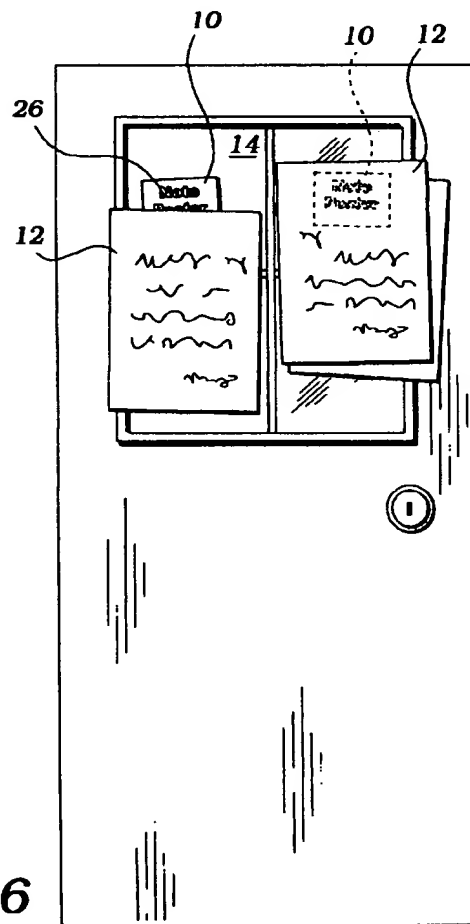


Fig. 6

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# METHOD OF MANUFACTURING A NOTE POSTER

## CROSS-REFERENCE TO RELATED APPLICATIONS

Not Applicable

## STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH

Not Applicable

## BACKGROUND OF THE INVENTION

### 1. Field of the Invention

This invention relates generally to note posters, and more particularly to a method for manufacturing a plurality of note posters having a polymer adhesive layer for removably attaching the note posters to a surface.

### 2. Description of Related Art

The following art defines the present state of this field:

Borisof, U.S. Pat. No. 3,165,283, teaches a removable and re-usable adhesive fastening device for holding posters, bulletins, decorations, and other similar articles on windows, walls, or any other surfaces.

Frye, U.S. Pat. No. 5,275,367, teaches a reusable self securing plastic holding device for mounting onto a smooth clean polished surface and having a particular physical arrangement which absorbs and dissipates the sheer forces exerted thereupon by a held object.

Julseth, U.S. Pat. No. 4,478,384, teaches a fastening device for securing paper sheets or cards to a rigid surface. The fastening device includes a transparent resilient rectangular plastic sheet with an adhesive strip along its upper edge and a frictional pad near, but spaced from, its lower edge, the pad being at least as thick as the adhesive strip.

Redmer, U.S. Pat. No. 4,039,134, teaches a message holder comprising a plastic housing having a sloping roof with a spring loaded ball detent thereunder.

R. Goodman, U.S. Pat. No. 3,399,429, teaches a clamping device for sheets such as papers, films, charts, and the like, comprising a support member which has a gravity-biased roller that is moved by gravity into a clamping position in an inclined guideway.

L. S. Mayers, U.S. Pat. No. 3,350,045, teaches a holding device for holding an article or group of articles, such as a plurality of papers, on any convenient surface, such as a wall or desk, and which provides a readily available article holder for papers and the like, which is easily transportable and movable and which can be fixedly positioned in place by application of a slight pressure.

Mossini, U.S. Pat. No. 5,110,077, teaches a member that includes a three dimensional rigid central part which functions to support an object, and a flexible peripheral part, suitably covered with adhesive, which acts as a surface of contact, and therefore an anchorage, with the wall.

Frye, U.S. Pat. No. 5,121,896, teaches a reusable self securing plastic holding device for mounting onto a clean smooth surface. The device has a structure which contributes substantial load bearing capacity in being particularly adapted to resist shear force or peel back.

Lee, U.S. Pat. No. 5,046,696, teaches a holder for eyeglasses which may accept the temple portion of an

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eyeglass frame for supporting the eyeglasses in a vertical position and which may be mounted on any surface.

Frye, U.S. Pat. No. 4,756,498 and U.S. Pat. No. 4,310,137, teaches a surface mounted article holding device adhesively attached to a supporting surface.

Mobley et al., U.S. Pat. No. 5,102,714, teaches a polyurethane adhesive prepared from a reaction mixture containing small amounts of chain extender material and a high equivalent weight of a polyol and a monoalcohol.

Luce, U.S. Pat. No. 5,464,681, teaches a replaceable adhesive display comprising a paper, metallized paper, or foil substrate printed on one or both sides with the same or different images, and at least one side is provided with a transparent overlay.

Fagan, U.S. Pat. No. 4,783,354, teaches a sheet material which can be firmly adhered to a surface, and yet readily removed therefrom, without the necessity of pre-wetting and without damaging the surface.

Huang, U.S. Des. Pat. No. 419,192, teaches an ornamental design for magnet memo clip and pen holder.

WO 97/01483, teaches an adhesive system for sticking all-round labels. The system includes a priming adhesive which is active while the label is applied and a covering adhesive for permanently sticking the label overlap.

The prior art teaches various devices that utilize an adhesive to removably attach an item to a surface. However, the prior art does not teach a method of manufacturing a plurality of note posters from a printed medium that has been printed with a plurality of images and attached to a polymer adhesive layer that allows the printed medium to be readily attached to the surface and removed without damaging the surface or leaving a sticky residue. The present invention fulfills these needs and provides further related advantages as described in the following summary.

## SUMMARY OF THE INVENTION

The present invention teaches certain benefits in construction and use which give rise to the objectives described below.

The present invention provides a method of manufacturing a plurality of note posters, and a method for using one of the plurality of note posters to removably secure a paper note to a surface. The plurality of note posters are manufactured from a printed medium having a printed surface and an opposing adhesive surface. A plurality of images are printed upon the printed surface. Once it has been printed, the printed medium, preferably a planar vinyl sheet, is laid in a horizontal position with the adhesive surface facing upwards, and a liquid polymer adhesive is poured onto the adhesive surface such that the liquid polymer adhesive spreads across and evenly covers the planar vinyl sheet to form a polymer adhesive layer. The planar vinyl sheet is then die-cut around each of the plurality of images, thereby forming the plurality of note posters. The polymer adhesive layer forms a tacky surface on each of the plurality of note posters useful for removably securing a paper note to a surface.

A primary objective of the present invention is to provide a method of manufacturing a plurality of note posters, the method of manufacturing having advantages not taught by the prior art.

Another objective is to provide a note poster that provides both a printed surface and a tacky surface for removably

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attaching the note poster to a surface without damaging the surface when the note poster is removed, or leaving a sticky residue.

Other features and advantages of the present invention will become apparent from the following more detailed description, taken in conjunction with the accompanying drawings, which illustrate, by way of example, the principles of the invention.

#### BRIEF DESCRIPTION OF THE DRAWING

The accompanying drawings illustrate the present invention. In such drawings:

FIG. 1 is a top perspective view of a printed surface of a planar vinyl sheet before the a planar vinyl sheet has been cut into a plurality of note posters;

FIG. 2 is a bottom plan view thereof illustrating a liquid polymer adhesive being poured onto an adhesive surface of the planar vinyl sheet to form a polymer adhesive layer;

FIG. 3 is a sectional view thereof taken along line 3—3 in FIG. 1 once the polymer adhesive layer has polymerized;

FIG. 4 is a top plan view of one of the plurality of note posters being used to removably attach a paper note to a surface;

FIG. 5 is a sectional view similar to FIG. 3, but showing the addition of a second polymer adhesive layer; and

FIG. 6 is a top plan view of one of the plurality of note posters being used to removably attach the paper note to the second polymer adhesive layer.

#### DETAILED DESCRIPTION OF THE INVENTION

The above described drawing figures illustrate the invention, a method of manufacturing a plurality of note posters 10, and a method for using one of the plurality of note posters 10 to removably secure a paper note 12 to a surface 14.

As shown in FIG. 1, the plurality of note posters 10 are manufactured from a printed medium 20 having a printed surface 22 and an opposing adhesive surface 24. The printed medium 20 is preferably a planar vinyl sheet 20, although equivalent materials such as plastic, paper, and other materials are also acceptable and within the scope of the claimed invention. A plurality of images 26 are printed upon the printed surface 22 using printing techniques, such as screen printing, that are well known in the art. To increase efficiency, the planar vinyl sheet 20 should be large and printed with many repeating copies of the printed image, so that the planar vinyl sheet 20 can be cut into the plurality of note posters 10 using a die or similar cutting mechanism. Each of the plurality of note posters 10 is preferably imprinted with the same image, typically a company logo or similar advertising. Each of the plurality of images 26 preferably includes advertising materials and contact information, to maximize the usefulness of the note poster 10 as an advertising venue.

Once it has been printed, the planar vinyl sheet 20 is laid in a horizontal position with the adhesive surface 24 facing upwards, as shown in FIG. 2, and a liquid polymer adhesive 30 is poured onto the adhesive surface 24 such that the liquid polymer adhesive 30 spreads across and evenly covers the planar vinyl sheet 20 to form a polymer adhesive layer 32. The liquid polymer adhesive 30 is a polyurethane or a polyester, and is preferably similar in composition to Mobley et al., U.S. Pat. No. 5,102,714, which is hereby incorporated by reference. The polymer adhesive layer 32 pro-

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vides a tacky surface 34 that can be readily peel-removed from the surface 14 without leaving a residue; and the polymer adhesive layer 32 can also be washed with water to remove dust and other contaminants to restore the tacky consistency of the polymer adhesive layer 32.

As shown in FIG. 3, once the liquid polymer adhesive 30 is allowed to polymerize, it forms the polymer adhesive layer 32 which is permanently bonded with the adhesive surface 24 of the planar vinyl sheet 20 so that the polymer adhesive layer 32 cannot be removed from the planar vinyl sheet 20. The polymer adhesive layer 32 also forms a tacky surface 34 opposite the planar vinyl sheet 20. The tacky surface 34 can form a temporary, removable bond with the surface 14, and yet be readily peel-removed without harming the surface 14 or leaving a residue. The planar vinyl sheet 20 is then die-cut around each of the plurality of images 26, thereby forming the plurality of note posters 10.

As shown in FIG. 4, each of the plurality of note posters 10 is then used for removably securing a paper note 12 to a surface 14. One of the plurality of note posters 10, whose manufacture is described above, is positioned on the surface 14 overlapping the paper note 12. The tacky surface 34 removably sticks to both the paper note 12 and the surface 14, thereby allowing the paper note 12 to be removably secured to the surface 14. The paper note 12 can readily be moved or removed by peeling the note poster 10 from the surface 14; and if the note poster 10 ever becomes so dirty that it does not stick effectively, the note poster 10 can be washed in water to remove the dirt and restore the tackiness of the tacky surface 34.

In an alternative embodiment, as shown in FIG. 5, the planar vinyl sheet 20 is flipped after the polymer adhesive layer 32 has polymerized and a second polymer adhesive layer 40 is poured to cover the printed layer. The second polymer adhesive layer 40 is preferably transparent so that each of the plurality of images 26 can readily be seen through the second polymer adhesive layer 40.

As shown in FIG. 6, each of the plurality of note posters 10 is removably attached to the surface 14 with the polymer adhesive layer 32; and the paper note 12 is removably attached to the note poster 10 with the second polymer adhesive layer 40. This provides an excellent tool for removably mounting the paper note 12 onto the surface 14. As described above, despite the presence of the second polymer adhesive layer 40, the printed surface 22 still retains its ability of display each of the plurality of images 26.

To facilitate the transport and storage of each of the plurality of note posters 10, the tacky surface 34 of the polymer adhesive layer 32 is preferably covered with a release liner 50. The second polymer adhesive layer 40 is preferably covered with a second release liner 52. The release liner and the second release liner 52 are preferably constructed of wax paper or a similar material that can be peel-removed from the polymer adhesive layer 32 and the second polymer adhesive layer 40, respectively, to expose the adhesive for use.

While the invention has been described with reference to at least one preferred embodiment, it is to be clearly understood by those skilled in the art that the invention is not limited thereto. Rather, the scope of the invention is to be interpreted only in conjunction with the appended claims.

What is claimed is:

1. A method of manufacturing a plurality of note posters, the method comprising the steps of:

a) providing a planar vinyl sheet having a printed surface and an opposing adhesive surface;

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- b) printing a plurality of images upon the printed surface;
  - c) lying the planar vinyl sheet in a horizontal position with the adhesive surface facing upwards;
  - d) pouring a liquid polymer adhesive onto the adhesive surface such that the liquid polymer adhesive spreads across and covers the planar vinyl sheet;
  - e) allowing the liquid polymer adhesive to polymerize, thereby forming a polymer adhesive layer having a permanent bond with the adhesive surface of the planar vinyl sheet, the polymer adhesive layer having a tacky surface opposite the planar vinyl sheet; and
  - f) cutting the planar vinyl sheet around each of the plurality of images, thereby forming the plurality of note posters.
2. The method of manufacturing of claim 1 wherein the liquid polymer adhesive is a polyurethane.
3. The method of manufacturing of claim 1 wherein the liquid polymer adhesive is a polyester.
4. The method of manufacturing of claim 1 further comprising the steps of:
- flipping the planar vinyl sheet, once the polymer adhesive layer has formed; and
  - pouring the liquid polymer adhesive onto the printed surface to form a second polymer adhesive layer.

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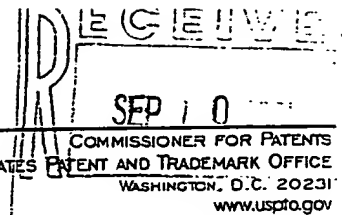
5. The method of manufacturing of claim 4 wherein the second polymer adhesive layer is transparent.
6. A method of manufacturing a plurality of note posters, the method comprising the steps of:
- a) providing a printed medium having a printed surface and an opposing adhesive surface,
  - b) printing a plurality of images upon the printed surface;
  - c) lying the printed medium in a horizontal position with the adhesive surface facing upwards;
  - d) pouring a liquid polymer adhesive onto the adhesive surface such that the liquid polymer adhesive spreads across and covers the printed medium;
  - e) allowing the liquid polymer adhesive to polymerize, thereby forming a polymer adhesive layer having a permanent bond with the adhesive surface of the printed medium, the polymer adhesive layer having a tacky surface opposite the printed medium, and
  - f) cutting the printed medium around each of the plurality of images, thereby forming the plurality of note posters.
7. The method of manufacturing of claim 6 wherein the liquid polymer adhesive is a polyurethane.
8. The method of manufacturing of claim 6 wherein the liquid polymer adhesive is a polyester.

\* \* \* \* \*





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**Applicant(s)**

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